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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,766	01/25/2001	Ofir Paz	14531.107.1.5	7764
47973	7590	11/16/2004	EXAMINER	
WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			SHANNON, MICHAEL R	
		ART UNIT	PAPER NUMBER	
			2614	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/770,766	PAZ ET AL.
Examiner	Art Unit	
Michael R Shannon	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 January 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 and 30-44 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 27-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 January 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20010312</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 22-26, drawn to a charge accumulation method, classified in class 725, subclass 1.
 - II. Claims 27-29, drawn to an interactive television channel selection method and control thereof, classified in class 725, subclass 39.
 - III. Claims 30-35, drawn to a method for generating a plurality of displays, classified in class 725, subclass 135.
 - IV. Claims 36-44, drawn to a method of transmitting compressed video channels targeted to a display location, classified in class 725, subclass 34.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as the use of an interactive television signal, including a WWW page, to interactively select and tune to a specific channel, with no direct use in a pay-per-view or video-on-demand system that would require billing/charging. See MPEP § 806.05(d).
3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as generating differentially modified displays for transmission to a user device

based on an instantaneous resource limitation, with no direct correlation to a charge accumulation method. See MPEP § 806.05(d).

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as transmitting a plurality of compressed video streams and receiving and modifying the received video streams with others of the plurality of video streams, which, again, has no direct correlation to a charge accumulation method. See MPEP § 806.05(d).

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as generating differentially modified displays for transmission to a user device based on an instantaneous resource limitation, not including a WWW page for interaction therewith. See MPEP § 806.05(d).

6. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as transmitting a plurality of compressed video streams for modification by other compressed video streams at the receiving end, no WWW page for channel selection is necessary. See MPEP § 806.05(d).

7. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as modifying compressed video channels at the display location based on other transmitted channels, such as with advertisement insertion. See MPEP § 806.05(d).

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and the search required for any one group is not required for another, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. During a telephone conversation with Jens Jenkins (44803) on 25 October 2004 a provisional election was made without traverse to prosecute the invention of group II, claims 27-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-26 and 30-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Eyer et al US patent 5,982,445, cited by examiner.

Regarding claim 27, the claimed method of interactive TV is met as follows:

- The claimed step of displaying, at an interactive TV, a WWW page including indications for TV channels is met by the HTML display of a programming guide or other channel indications [col. 4, lines 21-57].
- The claimed step of detecting an interaction of a user with one of the indications is met by the ability for the user to select buttons and/or text as discussed in column 5, lines 1-10.
- The claimed step of displaying a TV channel on the interactive TV responsive to the detection of interaction is met by the ability for the set

top box to change channels in response to a user selection [col. 4, lines 21-57].

Regarding claim 28, the claimed TV channel comprising a pay-on-demand movie is met by the fact that the channels of Eyer et al can be pay-per-view movies [col. 4, lines 21-57].

Regarding claim 29, the claimed method of interactive TV is met as follows:

- The claimed step of providing a compressed video stream representing a TV channel is met by the discussed video programming service signal [col. 4, lines 58-65].
- The claimed step of overlaying on said compressed video stream an interaction layer, including at least one control is met by the ability to overlay the display data signal onto the video program [col. 4, lines 58-65].
- The claimed step of receiving from a viewer of the video stream an interaction with the control, wherein the overlaying comprises overlaying a compressed interaction layer on the compressed video, without decompressing the compressed video is met by the user's ability to invoke the hyperlinks and controls in the overlayed information [col. 4, line 58 – col. 5, line 10].
- The claimed step of modifying the compressed video stream responsive to the received interaction is met by the ability for the video programming signal to be changed based on the user interaction with the overlay layer [col. 4, lines 58-65].

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kikinis US patent 6,205,485 discloses a system for displaying a WEB page with user interactions used for tuning to a channel.

Moeller et al US patent 5,828,370 disclose a system for overlaying icons (an interaction layer) on a video-on-demand movie for control of the selected compressed movie.

Form 892 (Notice of References Cited) contains a list of informally submitted IDS (1449) entries (those marked with an *). The IDS was submitted and entered as a record on the file with date 03/12/2001, however, no IDS was present in the file folder. Applicant unofficially submitted an IDS on 08/31/2004, which was used in this office action. Official submission of the formal IDS is requested via fax number 703-872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Shannon whose telephone number is 703-305-6955. The examiner can normally be reached on M-F 7:30-5:00, alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
October 26, 2004



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600